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10/066,756	02/06/2002	Tatsuaki Osafune	HITA.0157	4765

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REED SMITH LLP  
3110 FAIRVIEW PARK DRIVE, SUITE 1400  
FALLS CHURCH, VA 22042

EXAMINER
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SCUDERI, PHILIP S

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

## Office Action Summary

Application No.

10/066,756

Applicant(s)

OSAFUNE ET AL.

Examiner

Philip S. Scuderi

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 1 and 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed on June 22, 2005. Claims 1-6 are amended. Claims 7-10 are cancelled. Claims 11-14 are new claims.

### *Response to Amendment*

2. The reply filed on June 22, 2005 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):
3. Applicant acknowledges that claim 2 was previously objected to. However, Applicant did not amend the claim or argue the objection.
4. Applicant indicates that the drawings and the specification have been amended as required, however there are no replacement drawing sheets or amendments to the specification on the record.
5. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

### *Response to Arguments*

6. Applicant's amendment introduces new matter into claim 1. Applicant states that the first network address (i.e. a public IP address) assigned to the user computer from the ISP (Remarks p. 6 lines 11-12) is sent to the user computer (Remarks p. 6 line 14). However, the specification does not support this step. Applicant cites p. 12 line 3 in support of the step above. In the specification (p. 12 line 3), the private address is sent to the user computer, not the public address assigned from the

Art Unit: 2153

ISP. Pursuant to MPEP § 706.03(o), Examiner has rejected claims 1-5 and 11 under 35 U.S.C. § 112, first paragraph.

7. Applicant's arguments with respect to the Network Address Translator being located in a network external to any ISPs have been fully considered and are persuasive. Claim 6 distinguishes over the previously cited prior art because the claim is drafted in such a way that the translation apparatus must be external to the ISP. Accordingly, the rejection of claim 6 has been withdrawn. However, upon further consideration, a new ground(s) of rejection has been made that was necessitated by Applicant's amendments.

#### *Drawings*

8. Applicant indicates that the drawings and the specification have been amended as required, however there are no replacement drawing sheets or amendments to the specification on the record. Accordingly, the objections to the drawings and the specification still apply.

9. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 2153

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 307, 705, 811, 822, 823, 832, 833, 1001, 1106, 1303, and 1304. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

11. Applicant indicates that the specification has been amended as required, however there are no amendments to the specification on the record. Accordingly, the objections to the specification still apply.

12. The disclosure is objected to because the reference the PC using reference number 111 on p. 3 line 25 is invalid. Examiner suggests using reference number 211.

13. The disclosure is objected to because the reference to private address "a.b.c.d" using reference number 512 on p. 12 line 15 is invalid. Examiner suggests using reference number 521.

14. The disclosure is objected to because the reference to global address "f.g.h.i" using reference number 831 on p. 16 line 7 is invalid. Examiner suggests using reference number 931.

*Claim Objections*

15. Applicant acknowledges that claim 2 was previously objected to. However, Applicant did not amend the claim or argue the merits of the objection. Accordingly, the objection to claim 2 still applies.

16. Claim 1 is objected to because of the following informality: "connects to a user computer and an Internet service provider". Examiner suggests "connects to a user computer to ~~and~~ an Internet service provider" Appropriate correction is required.

17. Claim 2 is objected to because the claim recites the limitation "both items" in line 8. It is likely that applicant is referring to the user ID and the second network address, however this is not necessarily the case. Examiner suggests "said user ID and said second network address". Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

18. Examiner acknowledges that claim 1 has been amended to overcome the 35 USC § 112, second paragraph rejections of claims 3 and 5. Accordingly, Examiner has withdrawn the rejections.

19. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2153

20. Claims 1-5 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

21. Claim 1 recites the limitation "said network sending a first address assigned to said user computer from said Internet service provider to said access server". Global addresses (i.e. addresses assigned to a user computer by an Internet service provider) are assigned to users and registered in AT-GW 341 (e.g., the global address column in fig. 9, p. 15 lines 13-17). Global addresses are never sent to the user computer.

*Claim Rejections - 35 USC § 103*

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 6 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. (U.S. 6,490,289, hereinafter "Zhang") in view of Applicant Admitted Prior Art (Specification p. 1-4, figures 1-2, hereinafter "AAPA", see MPEP § 2129), further in view of Gelman et al. (U.S. 6,493,348, hereinafter "Gelman"), and further in view of Guerin et al. (U.S. 6,243,754, hereinafter "Guerin").

Art Unit: 2153

24. With respect to claim 6, Zhang discloses an address translation apparatus (fig. 3 (82)), which is connected to plural user computers (fig. 3 (80, 86a, 86b)), and to a plural service providers (fig. 3 (92, 94, 96)), comprising:

connecting a user to one of the service providers (col. 4 lines 56-59) and sending a private network address assigned to said user to said user (col. 5 lines 4-10) by using a point-to-point protocol (col. 2 lines 52-55);

a translating part which translates the private network address into a public IP network address (col. 5 lines 4-10) assigned to said user computer by one of the service providers (col. 4 lines 59-61); and

an output part which outputs said public IP network address to a network of said one of the service providers (col. 20 lines 20-24).

25. Zhang differs from the invention of claim 6 in that:

(a) Zhang does not expressly disclose that the apparatus is connected via a first router to an access server and via a second router to a network, which is connected to the service providers.

(b) Zhang does not expressly disclose authenticating the user when the user connects to a service provider (col. 4 lines 56-57).

(c) The service providers (fig. 3 (92, 94, 96)) are not Internet service providers.

26. Regarding (a), it was well known in the art that switching centers (e.g., Zhang fig. 3) utilize Local IP Networks to connect users to service providers, as evidenced by AAPA (fig. 1 (103)).

Given the teachings of AAPA, it would have been obvious to one of ordinary skill in the art to make address translation apparatus (Zhang fig. 3 (82)) part of a Local IP Network because AAPA fig. 1 is



Art Unit: 2153

presented as a conventional method for connecting to service providers (AAPA p. 2 lines 4-11).

Furthermore, it was well known in the art that IP networks comprise edge routers (i.e. first and second routers) for communicating with other networks (e.g., Gelman col. 5 lines 25-32). Given this information it would have been obvious to provide the Local IP Network with edge routers (i.e. first and second routers), thereby enabling administrators of the Local IP Network to filter incoming/outgoing packets, as was well known in the art (e.g., Gelman col. 5 lines 32-35).

27. Regarding (b), authenticating a user when the user connects to a service provider (e.g., the first network in Zhang col. 4 line 57) was well known, as evidenced by AAPA (specification p. 3 line 11-14). Given the teachings of AAPA, it would have been obvious to one of ordinary skill in the art to authenticate the user on the first network, thereby only providing access to authorized users.

28. Regarding (c), service providers (fig. 3 (92, 94, 96)) are not Internet service providers. However, providing access to multiple Internet service providers was well known in the art, as evidenced by Guerin. In a similar context, Guerin discloses a Local IP Network (fig. 1 (101)) and an edge router (fig. 1 (109)) that enable users to select from among multiple Internet service providers (fig. 1 (105, 107), abstract lines 3-5). Given the teachings of Guerin, it would have been obvious to one of ordinary skill in the art to use the instant teachings to enable users to select from among multiple Internet service providers, thereby enabling users to take advantage of different rates or services that might be provided by competing ISPs (Guerin abstract lines 17-20).

29. With respect to claim 12, Zhang-AAPA-Gelman-Guerin teaches the address translation apparatus applied to claim 6. Zhang further discloses that the network translation apparatus holds

Art Unit: 2153

the first network address and the second network address associated with a user (col. 5 lines 7-10).

Given the further teachings of Zhang and that it would have been obvious to one of ordinary skill in the art to authenticate the user on the first network (see (b) above), it would have been obvious to enable the address translation apparatus to further hold the user ID, since the address translation apparatus stores the other information associated with the user (first and second network addresses).

30. With respect to claim 13, Zhang-AAPA-Gelman-Guerin teaches the address translation apparatus applied to claim 6, wherein said private IP network address is used to access said one of the Internet service providers (Zhang col. 6 lines 20-24).

31. With respect to claim 14, Zhang-AAPA-Gelman-Guerin teaches the address translation apparatus applied to claim 6, wherein said public IP network address is used to access said network (col. 6 lines 20-24). The instant teachings do not expressly disclose accessing a server in said network. Examiner takes Official Notice that accessing a server through an ISP was very well known in the art. It would have been obvious to one of ordinary skill in the art to access a web server on the Internet using the instant invention. The motivation for doing so would have been to access service available on the Internet (e.g., checking stock prices at [finance.yahoo.com](http://finance.yahoo.com)).

### *Conclusion*

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2153

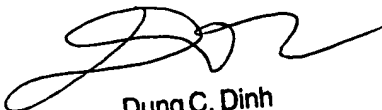
33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 8am-5pm.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSS



Dung C. Dinh  
Primary Examiner